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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Ibraheem T. BADEJO et al.

Group Art Unit: 1764

Application No.: 09/834,615

Examiner: J. LEUNG

Filed: April 16, 2001

Docket No.: 105841

For: ADHESIVE APPLICATORS WITH IMPROVED POLYMERIZATION INITIATORS

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the combined Restriction and Election of Species Requirement mailed October 1, 2004, Applicants respond as follows.

I. Restriction Requirement

The Office Action asserts a Restriction Requirement between Group I (claims 1-30 and 65-102) and Group II (claims 31-64). In response, Applicants elect Group I, claims 1-30 and 65-102, with traverse. Applicants respectfully request reconsideration and withdrawal of the Restriction Requirement.

A. The Restriction Requirement Should be Withdrawn

The Restriction Requirement asserts that Group I is distinct from Group II, noting that Groups I and II are related as a product and a process of making the product. Although Applicants agree that the inventions of Groups I and II may be independent or distinct as claimed, Applicants respectfully submit that the Restriction Requirement between Group I and Group II is improper, and should be withdrawn.

According to MPEP §803, there are ~~two~~ requirements that must be met before a proper Restriction Requirement may be made. These two requirements are: "The inventions must be independent . . . or distinct as claimed; and there must be a serious burden on the Examiner if restriction is not required . . . " (emphasis added). Applicants respectfully submit that the Office Action has failed to establish the second requirement set forth in MPEP §803, that a serious burden exists on the Examiner if restriction is not required between the Groups of claims.

In the present application, Group I is directed to an article of manufacture. Group II is directed to a method of making the article of manufacture of Group I. Applicants respectfully submit that a search for the subject matter of Group I would be commensurate with a search for the subject matter of Group II. Accordingly, search and examination of the subject matter of Group I would encompass a search for the subject matter of Group II, and any additional search would not impose a serious burden upon the Examiner.

It is therefore respectfully asserted that the search and examination of the entire application could be made without serious burden. MPEP §803 states that "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (Emphasis added). Because Applicants have elected Group I, directed to an article of manufacture, the further search and examination of Group II, directed to a method of making the article of manufacture, would not place a serious burden upon the Examiner.

For at least these reasons, and in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office, it is respectfully requested that the Restriction Requirement be reconsidered and withdrawn.

B. Rejoinder Will in Any Event be Required

As mentioned above, Group I is directed to an article of manufacture. Group II is directed to a method of making the article of manufacture of Group I.

Where product and process claims are presented in the same application, Applicant may be called upon under 35 U.S.C. §121 to elect claims to either the product or process. MPEP §821.04. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. *Id.*

In the present application, the method claims of Group II include all of the limitations of the product of Group I. In particular, all of the limitations of the independent product claim 1 of Group I are incorporated into the method of Group II, since at least claim 31 (Group II) depends directly from claim 1.

Since the method claims of Group II include the limitations of the product claims of Group I, the method claims must be rejoined with the product claims once the product claims are allowed. Thus, to streamline prosecution and avoid delay, the Restriction Requirement should be withdrawn to permit concurrent examination of all of the pending claims. Applicant respectfully requests reconsideration and withdrawal of the Restriction Requirement.

II. Election of Species Requirement

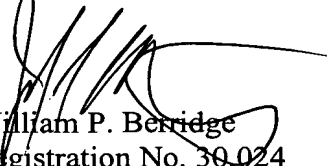
The Office Action requires election of a particular species of the article of manufacture of claim 1. In response to the Election of Species Requirement, Applicants hereby elect the species A, defined by claims 1-30, 96, and 99-102. This election is made with traverse.

In further response to the Election of Species Requirement, Applicants respectfully assert that it is believed that no claims are generic, and at least claims 1-30, 96, and 99-102 read on the elected species.

III. Conclusion

Early and favorable consideration of the application are respectfully requested. Should the Examiner have any questions regarding the application, or any suggestions to expedite prosecution, he is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,



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